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To: Commissioner for Patents for Examiner Ramsey Refai Group Art Unit 2152	Facsimile No. 571/273-8300
From: Stephanie Fay for Michele Morrow Legal Assistant to Gerald Glanzman	No. of Pages Including Cover Sheet: <u>45</u>
<p>Enclosed herewith:</p> <ul style="list-style-type: none"> • Transmittal; • Petition to Withdraw Finality of Office Action; • Final Office Action dated June 15, 2005; • Notice of Appeal dated September 13, 2005; • Final Office Action dated January 27, 2006; and • Final Office Action dated March 3, 2006. 	
<p>Re: Application Serial No. 09/881,872 Attorney Docket No. AUS920010383US1</p>	
<p>Date: Wednesday, May 03, 2006</p>	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **MAY 03 2006**

In re application of: Gupta

§ Group Art Unit: 2152

Serial No.: 09/881,872

§ Examiner: Refal, Ramsey

Filed: June 14, 2001

§ Attorney Docket No.: AUS920010383US1

For: Apparatus and Method for Selecting
Closing Information and Stationery for an
Electronic Mail Message Based on the
Intended Recipient

35525

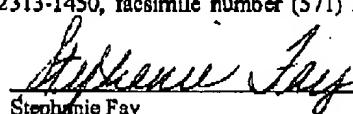
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

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on May 3, 2006.

By:

Stephanie Fay



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Commissioner for Patents
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Alexandria, VA 22313-1450

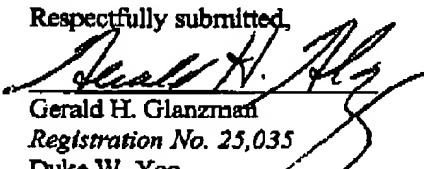
Sir:

ENCLOSED HEREWITH:

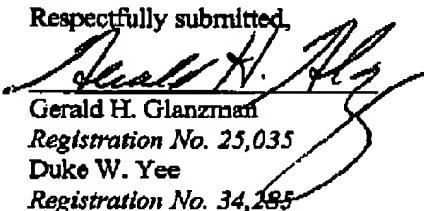
- Petition to Withdraw Finality of Office Action;
- Final Office Action dated June 15, 2005;
- Notice of Appeal dated September 13, 2005;
- Final Office Action dated January 27, 2006; and
- Final Office Action dated March 3, 2006.

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,


Gerald H. Glanzman

Registration No. 25,035


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Registration No. 34,185

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MAY 03 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gupta

§ Group Art Unit: 2152

Serial No.: 09/881,872

§ Examiner: Refal, Ramsey

Filed: June 14, 2001

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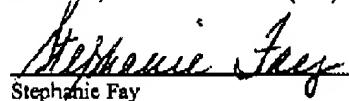
For: Apparatus and Method for Selecting
Closing Information and Stationery for an
Electronic Mail Message Based on the
Intended Recipient

§

Certificate of Transmission Under 37 C.F.R. § 1.8(a)

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By:


Stephanie Fay

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PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Sir:

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

In response to the Final Office Action corrected on March 3, 2006, please consider this Petition to Withdraw Finality of Office Action.

Statement of Fact

Petitioner respectfully petitions the withdrawal of the Final Rejection issued on March 03, 2006, on the grounds that the Final Rejection is premature. Petitioner filed an application on June 14, 2001. An initial rejection was issued on December 14, 2004. A Response was filed on March 14, 2005. A Final Office Action was issued on June 15, 2005. A Notice of Appeal was filed on September 13, 2005. An Appeal Brief was filed on November 14, 2005. In response to the Appeal Brief, the Examiner reopened prosecution and issued a new grounds of rejection along with a new Final Office Action on January 27, 2006. However, this new Final Office Action contained an error in the statement of rejection and a new corrected Final Office Action was issued on March 3, 2006. In the Final Office Action dated January 27, 2006 and corrected on March 3, 2006, the Examiner cited a new grounds of rejection based on new art. Originally, the claims in the application stood as rejected under 35 U.S.C. § 102 (e) as being unpatentable over Gilbert (U.S. Patent No. 6,529,942). In the newly issued Final Rejection the claims are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gilbert in view of Pedersen (U.S. Patent No. 6,965,920).

Petitioner called both the Examiner and the Examiner's supervisor to request withdrawal of the final rejection. Neither the Examiner nor the Examiner's supervisor was responsive to the request and did not want to participate in any discussion of the matter.

Copies of the Final Office Actions dated June 15, 2005; January 27, 2006; and corrected on March 3, 2006; along with a copy of the Notice of Appeal filed on September 13, 2005 are included in as support.

Points to be Reviewed

The point to be reviewed is whether the issuance of the final rejection in the Final Office Action corrected on March 3, 2006 was premature.

Action Requested

Petitioner respectfully requests that the final rejection be withdrawn.

Memorandum in Support of Request

According to the MPEP § 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

In the Final Office Action corrected on March 3, 2006, the Examiner states:

1. In view of the Appeal Brief filed on November 14, 2005. PROSECUTION IS HEREBY REOPENED. New Grounds of rejection are set forth below.

MPEP § 706.07(a) clearly states that an in case where the Examiner introduces a new grounds of rejection that is neither necessitated by Petitioner's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), then the Office Action cannot be made final. In the present case, the Examiner has stated in the Final Office Action corrected on March 3, 2006 that there are new grounds of rejection and that these new grounds are in response to the Appeal Brief filed on November 14, 2005. The Appeal Brief filed on November 14, 2005 contained no amendments to the claims or any proposed amendments to any claims. Thus, any new grounds of rejection recited by the Examiner and any new art cited the Examiner were not necessitated by an amendment made by the Petitioner.

The Pedersen reference is newly cited art, which was not part of any information disclosure statement made by the Petitioner. This citing of this art is not based on an amendment made by the Petitioner. Claim 1 of the application was amended in the Response filed on March 14, 2005. However, claim 1, as originally presented in the Application filed on June 14, 2001, referred to recipient profiles and the recipient profiles identifying an electronic mail message format. In the Response filed on March 14, 2005 as well as in the Appeal Brief filed on November 14, 2005, Petitioner has argued that the initial cited prior art, Gilbert, did not teach this feature. In the Final Office Action issued on January 27, 2006

and corrected on March 3, 2006, the Examiner applies the newly cited Pedersen patent as teaching this feature:

6. Gilbert fails to teach retrieving one or more recipient profiles from storage wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient.
7. However, Pedersen teaches an individual message generator that obtains information from recipient profiles stored in a database and generates individual messages for each recipient based on that information (abstract, column 2, lines 26-67, column 3, lines 48-65). It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Gilbert and Pedersen because doing so would provide a message management server that customizes electronic mail messages by referring to stored user-defined recipient profiles. The use of stored user-defined recipient profiles ensures that all messages addressed to that particular recipient are customized in the same way and allows for a recipient to easily change/update their profile to meet that recipient's preference.

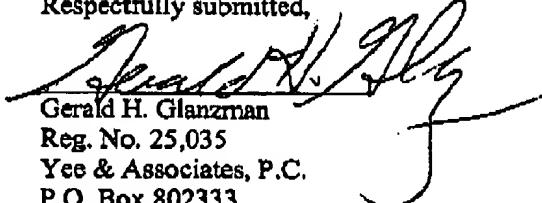
Therefore, the Examiner is citing Pedersen to address a feature that existed in the claim as the claims were originally drafted. Such a feature was not part of or created due to any amendment made by Petitioner.

Thus the Examiner issued a Final Office Action under new grounds of rejection that was neither necessitated by Petitioner's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Therefore, for all the reasons set forth above, Petitioner respectfully requests this Petition to Withdraw Finality of Office Action be granted.

DATE: May 3, 2006

Respectfully submitted,


Gerald H. Glanzman
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(972) 385-8777
Attorney for Petitioner

GHG/bj

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,872	06/14/2001	Bhupesh Gupta	AUS920010383US1	8222
38925	7590	06/15/2005		EXAMINER
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			REFAI, RAMSEY	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILBD: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CLIENT DOCKET INFORMATION

Client Name AUS920010383US1
File No. _____

DATE	ACTION DOCKETED
07.15.05	RFDA

Docketed By mg Date 06.21.05
Checked By JUR Date 06.22.05
Attorney Initials JUR Date 06/21/05

JUN 17 2005

Office Action Summary

Application No.	Applicant(s)
08/881,872	GUPTA, BHUPESH
Examiner	Art Unit
Ramsey Refal	2154

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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DETAILED ACTION*Response to Amendment*

1. Responsive to Amendment received on March 14, 2005.

Claims 1, 4, 6, 7, 10, 11, 14-17, 20-22, 25-28, 31-32, 35-38 and 41 have been amended.

Claims 1-41 remain presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (U.S. Patent No. 6,529,942).

4. As per claim 1, Gilbert teaches a method of formatting an electronic mail message, comprising:

retrieving one or more recipient profiles from storage (column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11; mail server reformats the content of the message by referring to profiles stored on the mail server that matches the recipient's user name to the identifier code, which represents the format specific to that corresponding user), wherein

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each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient (column 3, lines 3 – 22);

identifying a recipient of an electronic mail message (column 3, lines 3 – 5); ; and
formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11, column 3, lines 3 – 22);

5. As per claim 4, Gilbert teaches an electronic mail message directed to a plurality of designated recipients, and wherein formatting the electronic mail message includes identifying a set of compatible electronic mail format settings from among the content of electronic mail format settings of the designated recipients (column 4, lines 16-30).

6. As per claim 5, Gilbert teaches if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message (column 7, lines 47-48).

7. As per claim 6, Gilbert teaches electronic mail format settings include at least one of closing information, stationery, or whether to use spell check (column 6, lines 38-67, Figure 3, column 4, lines 64-66; user can select specific text in message to reformat. Also teaches spell checking).

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8. As per claim 7, Gilbert teaches electronic mail message is directed to a plurality of designated recipients (column 3, lines 13-16), and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each version of the electronic mail message is the same but the format is specific to the electronic mail format of a corresponding recipient profile (column 1, lines 54-61, column 3, lines 11-16, and column 4, lines 16-30).

9. As per claim 8, Gilbert teaches an electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message (column 1, lines 58-61).

10. As per claim 9, Gilbert teaches an electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them (column 1, lines 39-42; teaches that a user must view multiple versions of a message).

11. As per claims 11, 16-19, 21-22, 25-30, 32, and 35-40, these claims fail to add any further limitations and contain the same limitations as claims 1-9 above, therefore are rejected under the same rationale.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (U.S. Patent No. 6,529,942) in view of Schuetze et al (U.S. Patent No. 6,101,320).

14. As per claim 2, Gilbert fails to teach that one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.

15. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient's organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert and Schuetze et al because Schuetze et al's use of sending an email in a specific format to a recipient based on the recipient's organization in Gilbert's method would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

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16. As per claim 3, Gilbert fails to teach one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.

17. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization using the domain name of the organization (column 5, lines 1-3) and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient's organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert and Schuetze et al because Schuetze et al's use of sending an email in a specific format to a recipient based on the recipient's organization in Gilbert's method would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

18. As per claim 10, Gilbert teaches an electronic mail message is directed to more than one designated recipient (column 3, lines 13-16).

19. Gilbert fails to teach an electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes: identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, and an individual set of electronic mail format settings for each of

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the at least one designated recipient; comparing each set of electronic mail format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail message.

20. However, Schuetze et al teach electronic mail message includes identifying a common set of electronic mail content format settings for the more than one designated recipient (column 4, line 61 – column 5, line 3), and wherein identifying a common set of electronic mail content format settings includes: identifying at least one of a group set of electronic mail format settings (column 5, lines 43-46), a domain name category set of electronic mail content format settings (column 5, lines 1-3), and an individual set of electronic mail format settings for each of the at least one designated recipient (column 4, line 61 – column 5, line 3); comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail content format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail content message (column 9, line 66-column 10, line 15; shows that users in an organization would be grouped as one organization; therefore messages sent to recipients of the same organization would be sent in a message of the format of the recipients' organization). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert and Schuetze et al because Schuetze et al's use of sending an email in a specific format to a recipient based on the recipients organization in Gilbert's method would

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allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

21. As per claims 12-15, 20, 23-24, 31, 33-34, and 41, these claims fail to add any further limitations and contain the same limitations as claims 2-3 and 10 above, therefore are rejected under the same rationale.

Response to Arguments

22. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the applicant argues in substance that:
 - a. Gilbert does not teach retrieving one or more recipient profiles from storage and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient;
 - b. Schuetze does not teach formatting the content of an email message but rather is concerned with the transmission format expected by the recipient's electronic mail system;
 - c. Gilbert fails to teach the electronic mail message format settings include at least one of closing information, stationary or whether to use spell check.
- In reply to:
 - a. Examiner respectfully disagrees because although the word "profile" is not used, the functions of a profile are used in mail server 11. The mail server generates a properly formatted message for each recipient based on the matched identifier code to the

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recipient's user name in the mail server's memory. (See column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11.)

- b. Examiner respectfully disagrees because changing the transmission format of a message would inherently change all parts of the message, including the content.
- c. Examiner respectfully disagrees because Gilbert teaches that a user can select the desired text to be formatted from any portion of the content of the message. The software also allows the user to use spell check. (See column 4, lines 64-66; column 6, lines 38-67, Figure 3).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2154

RR
June 8, 2005


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
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Sep 13 2005 3:30PM YEE & ASSOCIATES, P.C. (972) 385-7766 F-1																
To: Commissioner for Patents for Executive Secretary Barth Group Amt Unit 2104 Facsimile No. 972-385-7766 From: Louis Foy No. of Pages Including Cover Sheet: 3 Paralegal to Dylan W. Yee 4100 Alpha Lane Suite 1100 Dallas, Texas 75244 Mail No. (972) 385-7777 Facsimile: (972) 385-7766																
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<table border="1"> <tr> <td>To: Commissioner for Patents for Executive Secretary Barth Group Amt Unit 2104</td> <td>Facsimile No. 972-385-7766</td> </tr> <tr> <td>From: Louis Foy Paralegal to Dylan W. Yee</td> <td>No. of Pages Including Cover Sheet: 3</td> </tr> <tr> <td colspan="2"> Enclosed herewith: • Transmittal document; and • Notice of Appeal </td> </tr> <tr> <td colspan="2"> Re: Application Serial No. 09/851,872 Attorney Docket No. A\3853001000TCB </td> </tr> <tr> <td colspan="2"> Date: Tuesday, September 13, 2005 </td> </tr> <tr> <td colspan="2"> Please contact us at (972) 385-7771 if you do not receive all pages indicated above or experience any difficulty in receiving this facsimile. </td> </tr> <tr> <td colspan="2"> <small>This Facsimile is intended only for the use of the addressee and/or the addressee's attorney or their agents, associates, principals and confidential informants. It may not be distributed outside of the addressee's law firm or outside of the addressee's attorney and his/her law firm. Any unauthorized distribution, copying or saving is strictly prohibited. If you receive this Facsimile in error, please notify us by telephone and return the facsimile to us immediately.</small> </td> </tr> </table>			To: Commissioner for Patents for Executive Secretary Barth Group Amt Unit 2104	Facsimile No. 972-385-7766	From: Louis Foy Paralegal to Dylan W. Yee	No. of Pages Including Cover Sheet: 3	Enclosed herewith: • Transmittal document; and • Notice of Appeal		Re: Application Serial No. 09/851,872 Attorney Docket No. A\3853001000TCB		Date: Tuesday, September 13, 2005		Please contact us at (972) 385-7771 if you do not receive all pages indicated above or experience any difficulty in receiving this facsimile.		<small>This Facsimile is intended only for the use of the addressee and/or the addressee's attorney or their agents, associates, principals and confidential informants. It may not be distributed outside of the addressee's law firm or outside of the addressee's attorney and his/her law firm. Any unauthorized distribution, copying or saving is strictly prohibited. If you receive this Facsimile in error, please notify us by telephone and return the facsimile to us immediately.</small>	
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To: Commissioner for Patents for Examiner Ramsey Rafa Group Art Unit 2184	Faximile No. #71/273-8300
From: Louise Fey Paralegal to Duke W. Yee	No. of Pages Including Cover Sheet: 3
Enclosed herewith <ul style="list-style-type: none"> • Transmittal document; and • Notice of Appeal. 	
Re: Application Serial No. 09/693,673 Attorney Docket No. AUSP2P010341US1	
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4100 Alpha Road
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To: Commissioner for Patents for Examiner Ramsey Refai Group Art Unit 2154	Facsimile No. 571/273-8300
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<p>Enclosed herewith:</p> <ul style="list-style-type: none"> • Transmittal document; and • Notice of Appeal. 	
<p>Re: Application Serial No. 09/881,872 Attorney Docket No. AUS920010383US1</p>	
<p>Date: Tuesday, September 13, 2005</p>	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE MAY 03 2006

In re application of: Gupta

§ Group Art Unit: 2154

Serial No.: 09/881,872

§ Examiner: Refai, Ramsey

Filed: June 14, 2001

§ Attorney Docket No.: AUS920010383US1

For: Apparatus and Method for
Selecting Closing Information and
Stationery for an Electronic Mail
Message Based on the Intended
Recipient

§ Certificate of Transmission Under 37 C.F.R. § 1.8(a)
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By: *Louise Fay*

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Sir:
ENCLOSED HEREWITH:

- Notice of Appeal

A fee of \$500.00 is believed to be necessary. Please charge this fee to IBM Corporation Deposit Account 09-0447. In the event that any additional fees are required for the prosecution of this application, please charge any necessary fees to IBM Corporation Deposit Account 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and the fee for this extension should be charged to IBM Corporation Deposit Account 09-0447.

Respectfully submitted,

[Handwritten Signature]
Stephen R. Tkacs
Registration No. 46,430
Agent for Applicant
Duke W. Yee
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of: Gupta

§ Group Art Unit: 2154

MAY 03 2006

Serial No.: 09/881,872

§

Examiner: Refai, Ramsey

§

Filed: June 14, 2001

§

Attorney Docket No.: AUS920010383US1

§

For: Apparatus and Method for
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Stationery for an Electronic Mail
Message Based on the Intended
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on May 13, 2005.

By:

Louise Fay

NOTICE OF APPEALCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the office action dated June 15, 2005 finally rejecting claims 1-41.

A fee of \$500.00 is believed to be necessary. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. In the event that any additional fees are required for the prosecution of this application, please charge any necessary fees to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and the fee for this extension should be charged to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,


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Page 1 of 1
Gupta - 09/881,872

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MAY 03 2006

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,872	06/14/2001	Bluopesh Gupta	AUS920010383US1	8222
35525	7590	01/27/2006	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380				REPAJ, RAMSEY
ART UNIT		PAPER NUMBER		
2152				

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CLIENT DOCKET INFORMATION
Client Name: AUS920010383US1

File No.

DATE ACTION DOCKETED
02.27.06 RFOADocketed By: mg Date: 02.27.06
Checked By: auto Date: 02.27.06
Attorney Initials: mg Date: 02.27.06

JAN 31 2006

Office Action Summary	Application No.	Applicant(s)
	09/881,872	GUPTA, BHUPESH
	Examiner Ramsey Refel	Art Unit 2152

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(e).

Status

1) Responsive to communication(s) filed on 14 November 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-41 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-41 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1448 or PTO/58/09)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-415)
 Paper No(s)/Mail Date, _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

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DETAILED ACTION

1. In view of the Appeal Brief filed on November 14, 2005, PROSECUTION IS HEREBY REOPENED. New Grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

2. Claims 1-41 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an

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application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (U.S. Patent No. 6,529,942) in view of Pedersen (U.S. Patent No. 6,965,920).

5. As per claim 1, Gilbert teaches a method of formatting an electronic mail message, comprising:

identifying a recipient of an electronic mail message (column 3, lines 3 – 5); and
formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11, column 3, lines 3 – 22).

6. Gilbert fails to teach retrieving one or more recipient profiles from storage wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient.

7. However, Pedersen teaches an individual message generator that obtains information from recipient profiles stored in a database and generates individual messages for each recipient based on that information (abstract, column 2, lines 26-67, column 3, lines 48-65). It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Gilbert and Pedersen because doing so would provide a message management server that customizes electronic mail messages by referring to stored user-defined recipient profiles. The use of stored user-defined recipient profiles ensures that all messages

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addressed to that particular recipient are customized in the same way and allows for a recipient to easily change/update their profile to meet that recipient's preference.

8. As per claim 4, Gilbert teaches an electronic mail message directed to a plurality of designated recipients, and wherein formatting the electronic mail message includes identifying a set of compatible electronic mail format settings from among the content of electronic mail format settings of the designated recipients (column 4, lines 16-30).

9. As per claim 5, Gilbert teaches if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message (column 7, lines 47-48).

10. As per claim 6, Gilbert teaches electronic mail format settings include at least one of closing information, stationery, or whether to use spell check (column 6, lines 38-67, Figure 3, column 4, lines 64-66; user can select specific text in message to reformat. Also teaches spell checking).

11. As per claim 7, Gilbert teaches electronic mail message is directed to a plurality of designated recipients (column 3, lines 13-16), and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each

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version of the electronic mail message is the same but the format is specific to the electronic mail format of a corresponding recipient profile (column 1, lines 54-61, column 3, lines 11-16, and column 4, lines 16-30).

12. As per claim 8, Gilbert teaches an electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message (column 1, lines 58-61).

13. As per claim 9, Gilbert teaches an electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them (column 1, lines 39-42; teaches that a user must view multiple versions of a message).

14. As per claims 11, 16-19, 21-22, 25-30, 32, and 35-40, these claims fail to add any further limitations and contain the same limitations as claims 1-9 above, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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16. Claims 2-3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (U.S. Patent No. 6,529,942) in view of Pedersen (U.S. Patent No. 6,965,920) and in further view of Schuetze et al (U.S. Patent No. 6,101,320).
17. As per claim 2, Gilbert fails to teach that one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.
18. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient's organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert, Pedersen and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.
19. As per claim 3, Gilbert fails to teach one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.
20. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization using the domain name of the organization (column 5, lines 1-3) and then

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determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient's organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert, Pedersen, and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

21. As per claim 10, Gilbert teaches an electronic mail message is directed to more than one designated recipient (column 3, lines 13-16).
22. Gilbert fails to teach an electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes: identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, and an individual set of electronic mail format settings for each of the at least one designated recipient; comparing each set of electronic mail format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail message.
23. However, Schuetze et al teach electronic mail message includes identifying a common set of electronic mail content format settings for the more than one designated recipient (column 4, line 61 – column 5, line 3), and wherein identifying a common set of electronic mail content

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format settings includes: identifying at least one of a group set of electronic mail format settings (column 5, lines 43-46), a domain name category set of electronic mail content format settings (column 5, lines 1-3), and an individual set of electronic mail format settings for each of the at least one designated recipient (column 4, line 61 – column 5, line 3); comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail content format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail content message (column 9, line 66-column 10, line 15; shows that users in an organization would be grouped as one organization; therefore messages sent to recipients of the same organization would be sent in a message of the format of the recipients' organization). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert, Pedersen, and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

24. As per claims 12-15, 20, 23-24, 31, 33-34, and 41, these claims fail to add any further limitations and contain the same limitations as claims 2-3 and 10 above, therefore are rejected under the same rationale.

Response to Arguments

25. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited in the Notice of Reference Cited for (PTO-892).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

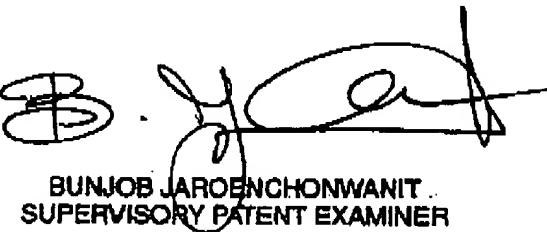
Application/Control Number: 09/881,872
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Ramsey Refai
Examiner
Art Unit 2152

RR *RR*
January 21, 2006



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

Notice of References Cited	Application/Control No. 09/881,872	Applicant(s)/Patent Under Reexamination GUPTA, BHUPESH	
	Examiner Ramsey Refai	Art Unit 2152	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-8,965,920	11-2005	Pedersen, Peter Henrik	709/208
*	B	US-6,483,482	10-2002	Smith et al.	709/208
*	C	US-8,890,773	02-2004	Law, Robert A.	379/88.22
*	D	US-8,438,215	08-2002	Skladman et al.	379/87.1
	E	US-			
	F	US-			
	G	US-			
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,872	06/14/2001	Bhupesh Gupta	AUS920010383US1	8222
35525	7590	03/03/2006	EXAMINER	
IBM CORP (YA)			REFAI, RAMSEY	
C/O YEE & ASSOCIATES PC			ART UNIT	
P.O. BOX 802333			PAPER NUMBER	
DALLAS, TX 75380			2152	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

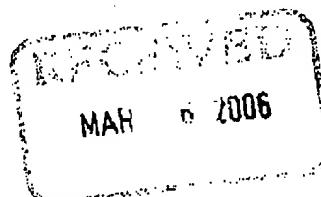
CLIENT DOCKET INFORMATION

Client Name: AUS920010383US1

File No.:

DATE	ACTION DOCKETED
<u>03.03.06</u>	<u>REOA</u>

Docketed By MAR Date 03.07.06
Checked By dlw Date 03.07.06
Attorney Initials J Date 3/7/06



<u>Supplements</u> <u>Office Action Summary</u>	Application No. 09/881,872	Applicant(s) GUPTA, BHUPESH
	Examiner Ramsey Refai	Art Unit 2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1448 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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DETAILED ACTION

This is a Supplemental Action to the Final Rejection mailed January 27, 2006.

1. In view of the Appeal Brief filed on November 14, 2005, PROSECUTION IS HEREBY REOPENED. New Grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

2. **Claims 1-41 are pending.**

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 rejected under 35 U.S.C. 103(a) as being unpatentable by Gilbert (U.S. Patent No. 6,529,942) in view of Pedersen (U.S. Patent No. 6,965,920).

5. As per claim 1, Gilbert teaches a method of formatting an electronic mail message, comprising:

identifying a recipient of an electronic mail message (column 3, lines 3 – 5); and

formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11, column 3, lines 3 – 22).

6. Gilbert fails to teach retrieving one or more recipient profiles from storage wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient.

7. However, Pedersen teaches an individual message generator that obtains information from recipient profiles stored in a database and generates individual messages for each recipient based on that information (abstract, column 2, lines 26-67, column 3, lines 48-65). It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Gilbert and Pedersen because doing so would provide a message management server that customizes electronic mail messages by referring to stored user-defined recipient profiles. The use of stored user-defined recipient profiles ensures that all messages

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addressed to that particular recipient are customized in the same way and allows for a recipient to easily change/update their profile to meet that recipient's preference.

8. As per claim 4, Gilbert teaches an electronic mail message directed to a plurality of designated recipients, and wherein formatting the electronic mail message includes identifying a set of compatible electronic mail format settings from among the content of electronic mail format settings of the designated recipients (column 4, lines 16-30).

9. As per claim 5, Gilbert teaches if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message (column 7, lines 47-48).

10. As per claim 6, Gilbert teaches electronic mail format settings include at least one of closing information, stationery, or whether to use spell check (column 6, lines 38-67, Figure 3, column 4, lines 64-66; user can select specific text in message to reformat. Also teaches spell checking).

11. As per claim 7, Gilbert teaches electronic mail message is directed to a plurality of designated recipients (column 3, lines 13-16), and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each

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version of the electronic mail message is the same but the format is specific to the electronic mail format of a corresponding recipient profile (column 1, lines 54-61, column 3, lines 11-16, and column 4, lines 16-30).

12. As per claim 8, Gilbert teaches an electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message (column 1, lines 58-61).

13. As per claim 9, Gilbert teaches an electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them (column 1, lines 39-42; teaches that a user must view multiple versions of a message).

14. As per claims 11, 16-19, 21-22, 25-30, 32, and 35-40, these claims fail to add any further limitations and contain the same limitations as claims 1-9 above, therefore are rejected under the same rationale.

15. Claims 2-3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (U.S. Patent No. 6,529,942) in view of Pedersen (U.S. Patent No. 6,965,920) and in further view of Schuetze et al (U.S. Patent No. 6,101,320).

16. As per claim 2, Gilbert fails to teach that one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the

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recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.

17. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient's organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert, Pedersen and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

18. As per claim 3, Gilbert fails to teach one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.

19. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization using the domain name of the organization (column 5, lines 1-3) and then determines the format used by the recipient organization (column 5, lines 43-46). A memory unit stores information regarding the email format of the recipient's organization (column 6, lines 1-16). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert, Pedersen, and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

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20. As per claim 10, Gilbert teaches an electronic mail message is directed to more than one designated recipient (column 3, lines 13-16).

21. Gilbert fails to teach an electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes: identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, and an individual set of electronic mail format settings for each of the at least one designated recipient; comparing each set of electronic mail format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail message.

22. However, Schuetze et al teach electronic mail message includes identifying a common set of electronic mail content format settings for the more than one designated recipient (column 4, line 61 – column 5, line 3), and wherein identifying a common set of electronic mail content format settings includes: identifying at least one of a group set of electronic mail format settings (column 5, lines 43-46), a domain name category set of electronic mail content format settings (column 5, lines 1-3), and an individual set of electronic mail format settings for each of the at least one designated recipient (column 4, line 61 – column 5, line 3); comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated

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recipient to identify matching sets of electronic mail content format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail content message (column 9, line 66-column 10, line 15; shows that users in an organization would be grouped as one organization; therefore messages sent to recipients of the same organization would be sent in a message of the format of the recipients' organization). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert, Pedersen, and Schuetze et al because doing so would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

23. As per claims 12-15, 20, 23-24, 31, 33-34, and 41, these claims fail to add any further limitations and contain the same limitations as claims 2-3 and 10 above, therefore are rejected under the same rationale.

Response to Arguments

24. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited in the Notice of Reference Cited for (PTO-892).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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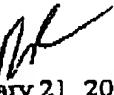
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

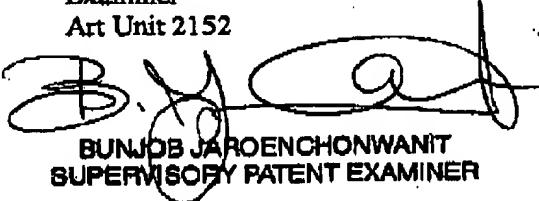
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2152

RR 
February 21, 2006


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

Notice of References Cited	Application/Control No.	Applicant(s)/Patent Under Reexamination	
	09/881,872	GUPTA, BHUPESH	
Examiner		Art Unit	Page 1 of 1
Ramsey Refal		2152	

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,965,820	11-2005	Pedersen, Peter Henrik	709/208
*	B	US-6,463,462	10-2002	Smith et al.	709/208
*	C	US-6,890,773	02-2004	Law, Robert A.	379/88.22
*	D	US-6,438,215	08-2002	Skiadman et al.	379/67.1
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